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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,735	08/25/2006	Daju Yuki	2006_1393A	8731
513 7590 06/21/2010 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
MARX, IRENE				
ART UNIT		PAPER NUMBER		
1651				
NOTIFICATION DATE		DELIVERY MODE		
06/21/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com

### Office Action Summary

**Application No.**

10/590,735

**Applicant(s)**

YUKI ET AL.

**Examiner**

Irene Marx

**Art Unit**

1651

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) 1-5 and 9 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 6-8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)  
Paper No(s)/Mail Date 5/25/10  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 5/25/10 is acknowledged. Claims 6-8 are being considered on the merits.

Claims 1-5 and 9 are withdrawn from consideration as directed to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ a specific strain of bacteria. It is not clear if the written description is sufficiently repeatable to avoid the need for a deposit. Further it is unclear if the starting materials were readily available to the public at the time of invention.

It appears that a deposit was made in this application as filed as noted on page 3 of the specification. However, it is not clear if the deposit meets all of the criteria set forth in 37 CFR 1.801-1.809. Applicant or applicant's representative may provide assurance of compliance with the requirements of 35 U.S.C § 112, first paragraph, in the following manner.

### **SUGGESTION FOR DEPOSIT OF BIOLOGICAL MATERIAL**

A declaration by applicant, assignee, or applicant's agent identifying a deposit of biological material and averring the following may be sufficient to overcome an objection and rejection based on a lack of availability of biological material.

1. Identifies declarant.
2. States that a deposit of the material has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.
3. States that the deposited material has been accorded a specific (recited) accession number.

4. States that all restriction on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.

5. States that the material has been deposited under conditions that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 CFR 1.14 and 35 U.S.C § 122.

6. States that the deposited material will be maintained with all the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty (30) years after the date of deposit for the enforceable life of the patent, whichever period is longer.

7. That he/she declares further that all statements made therein of his/her own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Alternatively, it may be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the purpose of Patent Procedure (e.g. see 961 OG 21, 1977) and that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.

Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession) number, date of deposit, name and address of the depository and the complete taxonomic description.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is confusing and incomplete in that the genus of the deposited strain is not claim designated. In addition, the amount of the control agent or the amount of the strain comprised

therein to be applied to the host plants is not clearly delineated. There is no clear nexus in the body of the claim between the preamble directed to "controlling plant diseases" and the sole active step of "application" to a host plant of plant pathogenic bacteria, fungi or viruses..

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kamata *et al.*, JP 08-175919, or Takahashi *et al.*, JP 02-209803, or Murayama *et al.*, JP-2003-289854, or Fushimi *et al.*, JP 05-051305, or Minato *et al.*, JP-2001-346407. or Inami *et al.*, JP 2003-277210, or Tateishi, H., JP 2003-089612, or Shoda *et al.* JP-06-133763, or Kinootka *et al.*, JP-05-091869, of record.

The claims are directed to a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant.

The references teaches a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant. See, e.g., Abstract.

Therefore, the invention is anticipated by the reference.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Phae *et al.*, of record

The claims are directed to a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant.

The reference teaches a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant. The plants treated include tomato, belonging to *Solanaceae*. See, e.g., Table 1.

Therefore, the invention is anticipated by the reference.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bergstrom *et al.*, 2003/0082792) of record

The claims are directed to a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant.

The reference teaches a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant. The plants treated include maize and wheat, belonging to *Graminaceae*. See, e.g., examples 4-7

Therefore, the invention is anticipated by the reference.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rossall *et al.*, U.S. Patent No. 5,344,647 of record

The claims are directed to a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant.

The reference teaches a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant. The plants treated include tomato, belonging to *Solanaceae*. See, e.g., Example 5.

Therefore, the invention is anticipated by the reference.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Neyra *et al.*, U.S. Patent No. 5,589,381.

The claims are directed to a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant.

The reference teaches a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant. The plants treated include tomato, belonging to *Solanaceae*. See, e.g. 14, lines 18-38.

Therefore, the invention is anticipated by the reference.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marrone *et al.*, U.S. Patent No. 6,004,774

The claims are directed to a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant.

The reference teaches a method of controlling bacteria, fungi or viruses in plants by applying *Bacillus* to the plant. The plants treated include strawberries and tomato, belonging to *Rosacea* and *Solanaceae*. (See, e.g., col. 12, lines 1-39, Example 12.

Therefore, the invention is anticipated by the reference.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant argues all of the anticipation rejections by stating that the method requires application of DAIJU-SIID2550 strain (accession number: FERM BP-10114) to a host plant of plant pathogenic bacteria, fungi, or viruses and that none of the references discloses this bacterium. However, applicant fails to consider that the material applied to a host plant is not the strain *per se* in an amount effective to control certain bacteria, fungi and/or viruses, but rather the claims are directed to application of an undisclosed amount of an agent or material that contains an undisclosed amount of the bacteria, which includes traces, to any host plant. The application of a composition containing a strain in an amount that is not clearly and unambiguously significant in its effects does not patentably distinguish the invention from the art of record that discloses application of compositions comprising *Bacillus* strains that are effective for the recited purpose.

Applicant has not demonstrated differences for the invention as claimed over the art of record.

Therefore the rejection is deemed proper and it is adhered to.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/  
Primary Examiner  
Art Unit 1651